

REMARKS

The Abstract and Specification have been amended. Claims 1, 3, 7, 10 - 13, and 16 have been amended to clarify the subject matter which Applicants regard as their invention. Claims 20 - 25 have been added. No new matter has been introduced with these amendments or added claims, all of which are supported in the specification as originally filed. Claims 1, 3 - 13, 16, and 20 - 25 are now in the application.

I. **Rejection under 35 U. S. C. §103**

Page 3 of the Office Action dated December 30, 2005 (hereinafter, "the Office Action") states that Claims 1, 3 - 13, and 16 are rejected under 35 U. S. C. §103(a) as being unpatentable over U. S. Patent Publication 2002/0103932 to Bilbrey et al. (hereinafter, "Bilbrey") in view of U. S. Patent Publication 2002/0052921 to Morkel. This rejection is respectfully traversed.

Each of Applicants' independent Claims 1, 7, and 12 specifies performing updates by, or at, a centralized server. See lines 10 - 11 of Claim 1, line 9 of Claim 7, and lines 13-26 of Claim 12. Page 4, lines 4 - 5 of the Office Action admit that Bilbrey "fails to specifically teach that said updating ... is done by the centralized server". Paragraph [0049] of Morkel is then cited as teaching this limitation, and the Office Action states that "it would have been obvious ... to modify the teachings of Bilbrey by updating of one or more recipient addresses by the centralized server as evidenced by Morkel ...". Office Action, p. 4, lines 6 - 13. Applicants respectfully request that the Examiner either cite prior art, or provide an

Examiner's affidavit, to establish a basis for this assertion.

With regard to Morkel, Applicants respectfully submit that the approach described in Morkel's para. [0049] cannot be aligned to their claimed language (whether this cited text is considered singly or in combination with Bilbrey): there are not enough distinct entities in Morkel, and those entities do not perform the actions, or store data, in the manner specified in Applicants' claim language, as will now be described.

- Editing: As shown in Morkel's Fig. 7, editing is done at an email client (Blocks 710 - 714), and this client sends "edited contact info." to the server (Block 718). In Applicants' claim language, a terminal "edit[s] a reference list" (Claim 1, line 6, emphasis added).
- Storage of recipient address list that will be updated: Morkel's Fig. 7 depicts a server retrieving a "list of recipients" from the server's own server database (Blocks 722 - 724). In Applicants' claim language, the "recipient address list" of an e-mail transmitter is sent, from the e-mail transmitter, to a centralized server for updating (Claim 1, lines 2 - 5).
- Updating: Morkel's Fig. 7 depicts the server performing the update (Block 732). In Applicants' claim language, the centralized server performs the update (Claim 1, lines 10 - 11). Notably, this centralized server is distinct from Applicants' e-mail transmitter which has the recipient address list that will be updated; by contrast, Morkel's server stores the recipient list and also updates it.

Accordingly, Applicants' claimed approach is clearly different from Morkel's approach. Applicants respectfully submit that the Office Action fails to explain how Bilbrey's approach and Morkel's approach could be combined to yield the limitations as claimed by Applicants.

With regard to Bilbrey, Applicants respectfully submit that the Office Action analysis of their independent Claim 1 (which also applies to independent Claim 7) on p. 3, lines 6 - 18 of the Office Action incorrectly uses the same element of Bilbrey for teaching two distinct elements of Applicants' claim language -- namely Applicants' claimed "e-mail transmitter" (Claim 1, lines 2 - 5) and Applicants' claimed "centralized server" (Claim 1, lines 10 - 16). In particular, reference number 102 ("sponsor database") of Bilbrey is cited as teaching both of these limitations from Applicants' independent Claim 1. See Office Action, p. 3, lines 7 - 8 (discussing "e-mail transmitter") and line 12 (discussing "centralized server", which has been misnamed in the Office Action as "sponsor database"). Applicants have amended their independent Claim 1 herein to explicitly specify that the e-mail transmitter and centralized server are distinct. See Claim 1, lines 17 - 18. Thus, it is clear that Bilbrey's "sponsor database" 102 cannot be cited for both Applicants' "e-mail transmitter" and Applicants' "centralized server".

In addition, Applicants respectfully submit that the "contact information" management taught by Morkel is not pertinent to their claimed invention. Morkel teaches that contact

information for a single user is processed at one time. In particular, the contact information for a sender of an e-mail message is updated. The updated (single person) contact information may be sent to one recipient, or to a plurality of recipients. See, for example, the following references, which all refer to the user in the singular:

- Abstract, lines 5 - 6 (“When a user’s information changes”; emphasis added);
- Fig. 3, reference number 318 (“Include identified contact information [of the sending user]”);
- para. [0007], lines 1 - 3 (“a user can send and/or update [his] personal information to selected recipients”, emphasis added) and lines 11 - 13 (“When the recipient opens the received e-mail, the recipient can securely obtain the user’s updated personal information”; emphasis added);
- para. [0010], lines 4 - 11 (“A sender’s computer ... includes an identifier associated with the sender’s contact information. A recipient’s computer ... retrieves from the server the contact information [of the sender]", emphasis added);
- para. [0040], lines 4 - 5 (“A subscriber (sender) composes an e-mail message which may ... include [the sender’s] contact information”; emphasis added);
- para. [0041], lines 3 - 5 (discussing a check sum that is computed over “the sender’s contact information, a sender’s secret ID and the recipient’s e-mail address”; emphasis added);
- para. [0047], lines 4 - 7 (“... when a user elects to update [his] contact information ... and communicates the updates to users in a list”; emphasis added);

added — notably, the list is a list of users who will be notified of the update, not a list of changes, as contrasted to Applicants' reference list; and

- para. [0049], lines 4 - 6 ("a user selects an address book entry and edits the entry"; emphasis added).

Furthermore, Morkel's approach of using a "livecard" to communicate updates to recipients indicates that it is the e-mail sender's own personal contact information that is being communicated (as contrasted to Applicants' use of a reference list that comprises a plurality of recipient addresses to be updated). See Morkel's Figs. 8 - 10, which illustrate an approach whereby one sender may notify many receivers of a change in that sender's own information. However, there is no teaching, nor any suggestion, in Morkel that this "livecard" technique can be used for updating addresses of multiple recipients. Accordingly, Morkel's approach is patentably distinct from Applicants' claimed updating technique, which uses a reference list that comprises a plurality of addresses to be updated (Claim 1, lines 6 - 7, "... a reference list comprising a plurality of recipient addresses to be updated"; Claim 7, lines 5 - 7, "... a difference list comprising a plurality of differences ..."; Claim 12, lines 6 - 8, "... a reference list comprising a plurality of updates ...").

Section 2143.03 of the MPEP, "All Claim Limitations Must Be Taught or Suggested", makes reference to *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970), which stated "*All words in a claim must be considered in judging the patentability of that claim against the prior art.*" (emphasis added). Applicants respectfully submit that Bilbrey's teachings cannot be

combined with Morkel's teachings to render their claimed invention obvious, as neither reference, nor a combination of the references, can be aligned with all of the words in the limitations specified in Applicants' independent Claims 1, 7, and 12. Accordingly, a *prima facie* case of obviousness has not been made out as to Applicants' independent claims.

Applicants therefore respectfully submit that their independent Claims 1, 7, and 12 are patentable over Bilbrey and/or Morkel. The dependent claims are therefore deemed patentable by virtue of (at least) the patentability of the dependent claims from which they depend. The Examiner is therefore respectfully requested to withdraw the §103 rejection of all remaining claims.

II. Conclusion

Applicants respectfully request reconsideration of the pending rejected claims, withdrawal of all presently outstanding rejections, and allowance of all remaining claims at an early date.

Respectfully submitted,

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